

27 FEB 2008



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In re Application of	:	DECISION ON RENEWED
CAMPBELL et al	:	
PCT No.: PCT/US2004/026981	:	
Application No: 10/569,021	:	
Int. Filing Date: 19 August 2004	:	PETITION UNDER
Priority Date: 20 August 2003	:	
Attorney's Docket No.: 2G02.1-082 1	:	
For: BLOOD SAMPLING DEVICE	:	37 CFR 1.47(a) and 137(b)

This is in response to the "Petition For Revival Of An International Application For Patent Designating The U.S. Abandoned Unintentionally Under 37 CFR 1.137(b) and PETITION TO ACCEPT SIGNATURE BY CO-INVENTOR ON BEHALF OF INVENTOR WHO REFUSES TO JOIN IN APPLICATION OR CANNOT BE REACHED (37 CFR 1.47(a))" filed on 28 January 2008.

BACKGROUND

In a decision from Office on 27 February 2007, the petition filed on 08 December 2006 was dismissed. The decision stated that applicants had not met item (2) under 37 CFR 1.47(a).

On 09 January 2008, the USPTO mailed applicant Notification of Abandonment (Form PCT/DO/EO/909) indicating that applicant has failed to respond to the notification of MISSING REQUIREMENT (Form PCT/DO/EO/905), mailed 09/07/2006 within the time period set therein.

On 28 January 2008, instant petition under 37 CFR 1.137(b) and 1.47(a), accompanied by, *inter alia*, by copies of the 1.47(a) petition filed on 08 December 2006 and the petition fee for revival of an unintentionally abandoned application

DISCUSSION

PETITION UNDER 37 CFR 1.137(b):

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by (1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a

continuing application; (2) the petition fee as set forth in § 1.17(m); and (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and (4) any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section.

Applicants have satisfied requirements (2), (3), and (4) under 37 CFR 1.137(b) but not requirement (1).

Applicants have not provided: (1) the proper reply because applicants have not addressed the issues raised by the dismissal decision on 27 February 2007 with respect to item (2). Applicants have basically re-submitted the petition originally filed on 08 December 2006.

Applicants have provided: (2) the petition fee set forth in § 1.17(m) and (3) the proper statement under 137(b)(3). In this application, no terminal disclaimer is required.

Accordingly, the petition is not deemed to satisfy requirements (1), (2), (3), and (4) under 37 CFR 1.137(b).

DECISION

The petition under 37 CFR 1.137(b) is **DISMISSED** without prejudice.

PETITION UNDER 37 CFR 1.47(a):

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Furthermore, section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.) **Proof of Unavailability or Refusal**, the relevant sections states, in part:

REFUSAL TO JOIN:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the **37 CFR 1.47** applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Applicants have still not satisfied requirement (2).

As stated in the previous decision, regarding requirement (2), in this case, it has been sufficiently demonstrated that a copy of the application papers were mailed to the non-signing inventor, Mitchell A. Solis but it is not clear if he received the papers. Although the FedEx Track states that it was delivered, it was left at the front door. Consequently, it is unclear if Mr. Solis received the papers because there is no signature of receipt by someone at the residence and petition also alleges not he could not be reached after diligent effort via phone calls.

Moreover, from the declaration, it appears that no further attempts were made to delivery the application papers so as to show that Mr. Solis actually received the delivery of the papers. Where the Office is being asked to accept the silence of the nonsigning inventor's as evidence of a refusal to sign, petitioner must provide some evidence that the application materials have been received by the nonsigning applicant. Absent further firsthand evidence that the application and request for signature were received by the nonsigning inventor, item (2) cannot be considered satisfied.

In addition, it is unclear if Mr. Solis still resides in that address. If not, then petitioner is under an obligation to try to find or reach Mr. Solis. Where there is an inability to find or reach a

joint inventor "after diligent effort, " petitioner may file a statement of facts that fully describes the exact facts which are relied on to establish that a diligent effort was made under **37 CFR 1.47**.

Consequently, the current record does not sufficiently establish Mr. Solis' refusal to join in the application because no evidentiary documents have been submitted in English to show that a *bona fide* attempt was made to deliver the complete application to him and that he received and signed for the papers.

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

The petition under 37 CFR 1.137(b) is **DISMISSED** without prejudice.

The application remains abandoned.

If reconsideration of the merits of the petition under 37 CFR 1.47(a) is desired, applicant must file a request for reconsideration within **TWO (2) MONTHS** from the mail date of this Decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a) and 137(b)."

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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